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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/049,438 | 05/30/2002 | Takahiro Nakajima | 11197/7 | 3695 |
| 23838 | 7590 | 03/08/2005 | EXAMINER | |
| KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005 | | | LEE, RIP A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1713 | |
| DATE MAILED: 03/08/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/049,438

Applicant(s)

NAKAJIMA ET AL.

Examiner

Rip A. Lee

Art Unit

1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.


Claim(s) objected to: _____.

Claim(s) rejected: 1, 4-7, 9, 10, 12, 14-16, 19-21 and 30-41.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: Applicants arguments are not persuasive. Regarding U.S. Patent No. 3,847,873 (Jackson et al.), the purported correlation between phosphorus retention and polymerization times empirical, and it does not appear to suggest to the skilled artisan a predictive measure of catalytic activity. While Applicants discussion of Y values has some merit, it is not germane to the case since the comparison is made between catalysts containing non-aromatic phosphorus compounds. Lastly, applicants attempt to correlate viscosity and polymerization activity is erroneous. The claimed combination remains obvious over the teachings of the prior art. There is no recitation in claim 1 of the patent which would discourage one of ordinary skill in the art from using the claimed combination of compounds. Regarding WO 99/28033 (Ridland et al.), it is maintained that one of ordinary skill in the art would have found it obvious to arrive at the subject matter of the present claims. While it is true that Ridland et al. does not exemplify the claimed invention, it must be appreciated that the rejection of record is based on obviousness rather than anticipation. In this connection, Applicants have not provided cogent reasons to support a case of non-obviousness. In light of this and previous discussions, the rejections of record have not been withdrawn.


March 03, 2005

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